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From: Ronald J. Kubovcik (Registration No. 25,401)
Date: January 15, 2008
Pages : 6 including this cover sheet.
Re : Appl. No. : 10/516,621 Confirmation No. 5295
Applicant : Tatsuo TSUNEKA et al.
Filed : December 3, 2004
TC/A.U. : 1796
Examiner : William K. Cheung
Dkt. No. : SAE-036
Cust. No. : 20374

Document transmitted herewith: (1) REQUEST FOR WITHDRAWAL OF FINAL
OFFICE ACTION DATED NOVEMBER 16, 2007

(Due: January 16, 2008)

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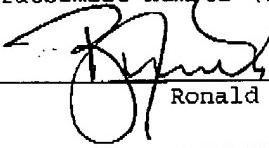
JAN 15 2008

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Ronald J. Kubovcik

REQUEST FOR WITHDRAWAL OF FINAL OFFICE ACTION
DATED NOVEMBER 16, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 15, 2008

Sir:

Applicants respectfully request withdrawal of the Final Office Action dated November 16, 2007, in the subject application. The Office fails to answer the substance of applicants' arguments presented in the response filed August 30, 2007.

In the Action of November 16, 2007, claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al., U.S. Patent No. 6,150,076 ("Yamamoto"), and as being unpatentable

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U.S. PATENT APPLN. S.N. 10/516,621
REQUEST FOR WITHDRAWAL OF
FINAL OFFICE ACTION

PATENT

over Yamamoto in view of Sales, U.S. Patent No. 5,169,888 ("Sales"). Each of these rejections was first made in the Action of May 30, 2007. The statements of rejection in the action of November 16, 2007, are identical to the statements of rejection as explained in the action of May 30, 2007.

In the response filed August 30, 2007, to the action of May 30, 2007, applicants argued that the method disclosed in Yamamoto for preparing the photosensitive resin compositions useful in the invention of Yamamoto, or as modified by Sales, does not meet the limitations of the method recited in claim 6 of the present application. Notwithstanding the insufficiencies of the cited references, applicants amended claim 6 to exclude components of the aqueous resin dispersion other than the acid-modified chlorinated polyolefin, basic substance and water.

Applicants also argued that notwithstanding any *prima facie* obviousness alleged by the Office to be supported by Yamamoto, alone or as modified by Sales, the showing in the Declaration (under 37 C.F.R. § 1.132) of Tatsuo TSUNEKA submitted with the response of May 22, 2006, of the criticality of the process sequence recited in claims 6-11 of the present application is sufficient to demonstrate the unobviousness of the process of the present invention. Applicants requested consideration of this

U.S. PATENT APPLN. S.N. 10/516,621
REQUEST FOR WITHDRAWAL OF
FINAL OFFICE ACTION

PATENT

showing.

In the "Response to Arguments" section of the action of November 16, 2007, the Office indicates that the arguments from the response filed August 30, 2007, have been fully considered but are not persuasive. However, the Office has completely ignored the arguments directed to the comparative data of the Declaration under 37 C.F.R. 1.132 filed in the present application. Since the Office does not respond to the arguments directed to comparative data, it appears that applicants' arguments have not been fully considered.

In maintaining a rejection, the Office is required to answer all material traversed. As set forth in MPEP §707.07(f): "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Furthermore, in holding applicants' arguments to be non-persuasive, the Office must "address all arguments which have not already been responded to in the statement of rejection." The Office is not permitted to answer only selected arguments in maintaining rejections of the claims. In the present action, the Office has not addressed arguments relating to comparative data in the statement of rejection or its

U.S. PATENT APPLN. S.N. 10/516,621
REQUEST FOR WITHDRAWAL OF
FINAL OFFICE ACTION

PATENT

response to arguments.

The comparative data of the Declaration under 37 C.F.R. 1.132 filed in the present application is relevant. The data establish the criticality of the sequence of steps of the claimed process and provide a comparison to prior art closer to the present invention than the prior art cited by the Office. Furthermore, remarks accompanying a pre-appeal brief request for review and relating to these comparative data resulted in the removal of the rejection of claims 6 to 11 under 35 U.S.C. 103(a) as being obvious over Ashihara et al. (U.S. Patent No. 6,277,912; hereinafter "Ashihara") in view of Verardi et al. (U.S. Patent No. 5,863,646; hereinafter "Verardi"). As explained in the response filed August 30, 2007, and in the response filed February 8, 2007, the comparative data demonstrate non-obviousness of the claims and rebut the Office's case of *prima facie* obviousness.

In view of the Office's failure to answer the substance of applicants' traversal of the rejections of the claims, withdrawal of the Action of November 16, 2007, and issuance of a new Action which properly responds to all points of argument in the response filed August 30, 2007, are in order and are respectfully requested.

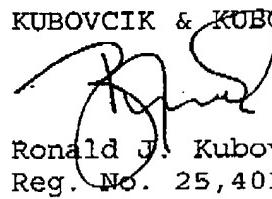
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REQUEST FOR WITHDRAWAL OF
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In the event any fees are required, please charge our Deposit
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Respectfully submitted,

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